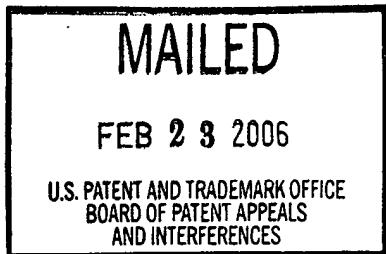


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

**Ex parte CHARLES C. BIRKNER, ELIAS GEORGE ELDAHDAH
and DAVID FREDERICK MARTINEZ**



Appeal No. 2005-2718
Application No. 09/696,465

ON BRIEF

Before THOMAS, JERRY SMITH and NAPPI, **Administrative Patent Judges**.

NAPPI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 20. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to a construction project information management system. See page 1 of appellants' specification. The system makes use of a handheld computer to collect construction data in the field, a planning system to track budgetary information, a design system to perform site engineering assessment and a construction system to track material consumption and progress for each project.

Claim 1 is representative of the invention and is reproduced below:

1. A construction management system, comprising:
a handheld computer adapted to collect construction data from the field;
a planning system to track budgetary information that manages multi-year budgets;
a design system to perform site engineering assessment; and
a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer.

Reference

The reference relied upon by the examiner is:

Meridian Project Systems, Inc. (www.mps.com), screenshots archived by archive.org between 12/1999 and 01/2000. (Meridian)

Additional References Used to Determine Meaning of Terms in Appellants' Specification and the Art. (Copies Attached)

Palm HotSync® Support, web page.
www.palm.com/us/support/hotsync.htm

Windows Mobile Download ActiveSync, web page.
(www.microsoft.com/windowsmobile/activesync/default.mspx)

Rejections at Issue

Claims 1 through 6, 8 through 12, and 14 through 20 stand rejected under 35 U.S.C. § 102 as being anticipated by Meridian. Claims 7 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Meridian.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejections of claims 1 through 6, 8 through 12, and 14 through 20 under 35 U.S.C. § 102, and the

examiner's rejection of claim 13 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claim 7 under 35 U.S.C. § 103.

Grouping of the Claims

At the outset, we note that appellants' arguments are directed to the individual rejections and do not address the individual claims. Accordingly, we group all of the claims rejected under 35 U.S.C. § 102 together and treat claim 1 as representative of that group of claims. However, as we find appellants' argument regarding the examiner's rejection under 35 U.S.C. § 103 of claims 7 and 13 convincing with respect to claim 7 and not with respect to claim 13, we group claims 7 and 13 separately.

Rejection of Claims 1 Through 6, 8 Through 12, and 14 Through 20 Under 35 U.S.C. § 102

Appellants assert on page 6 of the brief, that claim 1 calls for a "a planning system to track budgetary information that manages multi-year budgets." Appellants argue that:

Meridian accounting system cannot track funding sources, the allocation of the funding sources, and scheduling information. Meridian also cannot maintain data relating to preliminary site feasibility studies such as estimates of the costs of the project. Further, it cannot handle multi-year projects. Hence, at least the planning system is missing in Meridian and this is one basis to traverse the rejection.

In the instant invention, the specification discloses an embodiment of the planning system as a budgetary system that tracks funding sources, the allocation of the funding sources, and scheduling information. As noted on pages 16-17 of the application, in one embodiment, "the

planning system 102 includes a Fund/Source Module that maintains multi-year budget plans for the overall CIP [Capital Improvement Plan] process. This allows program managers to create a multi-year Capital Improvement Plans and track the funding sources by program, fund, and by source. Each CIP plan is controlled separately to maintain a historical record of the previous year's CIP plan. This Planning System controls and manages the data associated with this process." Meridian does not manage the multi-year capital improvement budget process for program management that requires a system to adjust projects based on priorities, condition assessments, and maintenance considerations. Since the planning system is not taught by Meridian, this is one basis for traversing the Section 102 rejection.

On pages 10 and 11 of the answer, the examiner responds stating:

[T]he features of the planning system argued by the Applicant [sic], that of tracking funding sources, allocating of funding sources and scheduling information, maintaining data relating to preliminary site feasibility studies, and other aspects of the planning system disclosed in the specification, are not recited in the claimed invention.

Further, on page 11 of the answer, the examiner identifies those sections of Meridian which support her finding that Meridian teaches a Planning system.

We concur with the examiner. In analyzing the scope of the claim, office personnel must rely on appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). "[I]nterpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original)

In re Cruciferous Sprout Litigation, 301 F.3d 1343, 1348, 64 USPQ2d 1202,

1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.*, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). Claim 1 includes the limitation of “a planning system to track budgetary information that manages multi-year budgets.” We find no limitations that the planning system tracks scheduling information, as appellants argue on page 6 of the brief. Similarly, we find no limitation that “requires a system to adjust projects based on priorities, condition assessments, and maintenance considerations,” as argued by appellants on page 7 of the brief. While the scope of the claim is broad enough to that it includes such systems, we do not find that the scope of the claim is limited to such a system. Rather, we consider the scope of the limitation directed to the planning system is broad and includes systems which track budgetary information, i.e. information directed to the allocation or resources, and that the system be capable of tracking budgets over multi-years.

We find that the Meridian system described in the series of web pages cited by the examiner teach hardware and software which together provide a project management system. See page 1, first paragraph and page 13 first paragraph. The system makes use of a handheld terminal, “Prolog Pocket” which can be carried in the field to document day to day construction activities. See page 1, first paragraph. The program Prolog Manager and Prolog Executive are software applications that store in a database the information related to a

project and generate reports. The Prolog Pocket can be used to "track material ... including deliveries, installations, and balance to deliver and install quantities." See page 3. Prolog Manager includes a purchasing and cost control software modules which allow managing "the entire procurement process". See page 13, first paragraph. These software modules also produce various reports listed on pages 14 and 15, these reports include several budget reports, several expenditure reports and several funding reports. Prolog Manager can be used to generate similar reports, additionally Prolog Manager allows for the generation of reports for multiple projects. We note that the articles make no mention of limiting the time frame of the projects that can be managed. Page 32 describes a three year project that was managed using the Meridian system. Thus, we find ample evidence in the articles cited by the examiner to support the examiner's finding that the Meridian system teaches the claimed "planning system to track budgetary information that manages multi-year budgets."

Appellants assert on page 7 of the brief:

The claims also recite a design system. As disclosed in the specification, in one embodiment, the design system 104 allows the user to perform detailed site assessments. The user can check for a variety of concerns, for example environmental concerns. The design system 104 also allows the user to start a preliminary design that meets predefined requirements on a particular project. The design system 104 also performs contract management aspects of the design contract, including tracking whether a design engineering company or an architectural firm has delivered certain items. The design system 104 also performs contract management and archives any court document control such as

correspondence between an owner and a design firm.

Appellants argue, on pages 7 and 8 of the brief:

Although page 15 of Meridian mentions the word “Engineering,” but the Meridian Engineering functionality is limited to document management for engineering diagrams and not a design system to perform site engineering assessment. To illustrate, page 15 is replete with logs, records of conversations, drawing history/list/packages, and submittal packages and transmittal cover sheet. However, there is no design functionality in Meridian.

In the instant application, one embodiment of the design functionality is described as follows: “The design system 104 allows the user to perform detailed site assessments. The user can check for a variety of concerns, for example environmental concerns.” Meridian is completely silent on the design system that can address environmental concerns in the claimed design system. Hence, at least the design system element is missing from Meridian.

On page 11 of the answer, the examiner responds by stating that the specific functions argued by the appellants are not recited in the claimed “design system.” On page 12 of the answer, the examiner identifies sections of the Meridian system, which the examiner considers to meet the claimed design system.

We concur with the examiner. Claim 1 includes the limitation “a design system to perform site engineering assessment.” We find no limitation that limits the scope of the claim to a design system, which performs engineering site assessments for environmental concerns as, asserted by applicant. Operations associated with the design module, are discussed on page 18 of appellants’

specification as including the initiation of meetings, interim progress reviews, coordination of conflicts of utilities and government agencies, performance of investigations, including an environmental investigation, analysis of real estate activities and drafting an engineering report. Pages 19 through 24 of appellants' specification identifies that the design modules manage the documentation of the various processes. Thus, appellants' disclosure describes the design system not performing the various activities, such as performance of investigations, but rather the activities which are performed by others, and the information and supporting documentation is stored and managed by the design module. Additionally, we find that the scope of the limitation of "design systems" include many other activities in addition to assessing environmental concerns. As such, we consider the limitation of a design system to be broad in scope and include systems, which manage information and documents involved in performing the engineering site assessment.

We find that the Meridian system described in the series of web pages cited by the examiner teaches a project management system, which does include a design system to the extent claimed. On page 13 of the web pages provided by the examiner, the program Prolog Manager is described as including engineering features and includes documents such as drawing packages and inspection and test data. Page 15 of the web pages provided by the examiner

lists the engineering reports generated by the Prolog Manager program; these reports include information on the drawings, issues and requests for information.

We consider this information and documentation to be information and documents involved in performing the engineering site assessment. Accordingly, we find that Prolog Manager includes features, which meets the claimed design system. Thus, we find ample evidence in the articles cited by the examiner to support the examiner's finding that the Meridian system teaches the claimed "design system."

On page 8 of the brief, appellants restate the examiner's findings related to the claimed "construction system". On pages 8 and 9 of the brief, appellants cite examples in appellants' specification that disclose operation of the construction system. Appellants' arguments do not contest the examiner's finding that Meridian teaches the claimed construction system. Nonetheless, we find that the examiner has presented ample evidence to support the finding that Meridian teaches the claimed "construction system."

Claim 1 includes the limitation "a construction system to track material consumption and progress for each project, the construction system adapted to receive data collected from the handheld computer." On page 12 of the answer the examiner states:

Meridian Project Systems, Inc. teaches a construction system to track material consumption and progress for projects using information

received from a handheld computer in page 1, sections 1-2, page 2, section 1, page 3, sections 1-5, page 4, page 13, sections 1-3, pages 14-16, page 17, sections 1-3, page 19, and page 28, sections 1-3.

We concur with the examiner. As identified *supra* we find that the Meridian includes a hand held computer, the "Prolog Pocket." Further, the list of reports, on pages 14-16 identify several reports which track material consumption and progress for each project. Accordingly, we find that the Meridian system teaches the claimed construction system.

For the forgoing reasons, we sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102. As discussed *supra*, appellants have not presented arguments as to why claims 2 through 6, 8 through 12, and 14 through 20 are separately patentable, accordingly we group claims 2 through 6, 8 through 12 and 14 through 20 with claim 1 and sustain the examiner's rejection of these claims for the reasons provided with respect to claim 1.

Rejection of claim 7 under 35 U.S.C. § 103

Appellants argue, on pages 10 and 11 of the brief, that claims 7 and 13 are dependent upon claim 1 and that claims 7 and 13 should be allowable for the reasons asserted with respect to claim 1.

For the reasons stated *supra* we are not persuaded by this argument.

Additionally, on pages 11 and 12 of the brief, appellants argue that the examiner has not provided concrete evidence of a suggestion to modify Meridian such that “the hand held computer collects equipment type, quantity, hours in use and stand-by hours or a hot-sync cradle coupleable to the handheld computer, the cradle hot-syncing the collected information for transmission to a server.”

Initially, we note claim 7 does not include a limitation directed as “hot-sync cradle”; claim 13 does. Accordingly we will address the “hot-sync cradle” limitation *infra*. Claim 7 depends on claim 1 and includes the limitation “wherein the handheld computer collects equipment type, quantity, hours in use and stand-by hours.”¹ The examiner states, on pages 8 and 9 of the answer: “[t]ype, quantity, hours in use and stand-by hours are all known equipment information items in the art.” While intuitively, the examiner’s assertion appears correct, we note that the examiner has presented no evidence to support this assertion. Our reviewing court has stated “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.”

In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

When determining obviousness, “[t]he factual inquiry whether to combine

¹ We note the language used in the claim is awkward as the handheld computer is disclosed as collecting data identifying the equipment type, quantity of equipment used etc., and not as collecting the equipment itself.

references must be thorough and searching.” *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, *citing McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “It must be based on objective evidence of record.” *Id.* “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617, *citing McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). The Federal Circuit states that, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, our reviewing court stated, that when making an obviousness rejection based on combination, “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant” in *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433 (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)). Thus, in the absence of evidence to support the examiner’s

assertion, we will not sustain the examiner's rejection of claim 7.

Rejection of Claim 13 Under 35 U.S.C. § 103

As identified *supra*, appellants argue that claim 13 should be allowable for the reasons asserted with respect to claim 1 and also because the examiner has not presented evidence of suggestion to use the handheld computer with a hot-sync cradle. We disagree.

Initially, we note, as the examiner identifies on page 9 of the answer, "HotSync is known in the art and is the registered trade name for a method of linking between handheld computer and a more substantial computer."² Appellants have not contested this assertion by the examiner, nor have appellants contested that HotSync cradles were well known; rather appellants contest the examiner's finding of motivation to use a HotSync cradle in the Meridian system. Further, our independent search of the Internet produced a document that identifies HotSync as a feature of the PALM® operating system which "enables you to synchronize and back up data between a palm device and a computer with the touch of a button." See web page www.palm.com/us/support/hotsync.htm, a copy of which is attached to this decision. Thus, we concur with the examiner determination of the scope of the

² It appears that HotSync may be a trademark; our cursory review has yielded conflicting information. The appellants and the examiner should insure that the specification and claims comply with MPEP section 608.01(v) concerning use of trademarks in a patent application.

claim limitation being directed to a method of linking a handheld computer to a more substantial computer.

The examiner further finds that "Meridian Project Systems, Inc. discloses a system further comprising a cradle coupleable to the handheld computer, the cradle gathering the collected information for transmission to a server (See page 1, sections 1-4, paged [sic] 5-6, page 8, section 1, pages 19-20 and page 28, sections 1-3, wherein the collected information is wirelessly transmitted. Page 8, section 1, discloses a technical requirement of a handheld unit as ActiveSync 3.0, which allows for coupling for transmission."

We concur with the examiner's findings. Further, our independent search of the Internet produced a document that identifies ActiveSync as being similar to HotSync in that it allows synchronization between mobile devices and more substantial computers. See web page www.microsoft.com/windowsmobile/activesync/default.mspx, a copy of which is attached to this decision. The difference appears to be that HotSync is for devices operating with the PALM® operating system and ActiveSync is for devices operating with the WINDOWS® operating system. Thus, we find that the examiner has presented objective evidence to modify the Meridian system to use "a hot-sync cradle coupleable to the handheld computer, the cradle hot-syncing the collected information for transmission to a server" as claimed in

claim 13. Accordingly, we sustain the examiner's rejection of claim 13 under 35 U.S.C. § 103.

Conclusion

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellant did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In summary, we sustain the examiner's rejections of claims 1 through 6, 8 through 12, and 14 through 20 under 35 U.S.C. § 102, and the examiner's rejection of claim 13 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claim 7 under 35 U.S.C. § 103. The appellants and the examiner should ensure that the issues noted in the footnotes of this decision

Appeal No. 2005-2718
Application No. 09/696,465

are addressed during the further prosecution of this patent application. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JAMES D. THOMAS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

~~ROBERT E. NAPPI~~
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

REN
Attachments:

Appeal No. 2005-2718
Application No. 09/696,465

TRAN & ASSOCIATES
6768 MEADOW VISTA CT.
SAN JOSE, CA 95135

RN/jrg